

REMARKS

Claims 4-10 are pending in the application. The Examiner has rejected Claims 4-10 under 35 U.S.C. §103(a) as being unpatentable over Nonami (U.S. Patent 6,647,258) in view of Moran (U.S. Patent App. Pub. 2002/0073142).

Please amend Claims 4 and 8 as set forth herein. No new matter has been added.

Regarding independent Claims 4 and 8, the Examiner states that the claims are obvious over Nonami in view of Moran. Nonami discloses a portable radio communication apparatus; and, Moran discloses a messaging system and method, which requires a user to first determine if a feature key is pressed and then enter a directory number.

Initially, several issues raised by the Examiner in the Response to Arguments section on page 2 of the Office Action need addressing.

First, the Examiner mistakenly categorizes a hypothetical example as an alleged admission. This is not correct. In the Response dated February 21, 2006, a hypothetical example was presented to assist in the understanding of the differences between the present invention and the cited references. Stated therein was the following hypothetical example, "In the combination of Nonami and Moran, if a call is not established and a message is to be sent to the called mobile terminal, the telephone number (or other identification of the called terminal) would need to be reentered after attempting the call and before sending the message." No admission was made. The foregoing statement was provided to show that the telephone number (or other identification of the called terminal) would need to be reentered after attempting the call and before sending the message. Any allegation that the foregoing statement serves as an admission is denied. Neither Nonami nor Moran, either alone or in combination, teach or disclose a situation where a call is not established, i.e. fails.

Second, the Examiner attempts to establish that Nonami and Moran teach a predetermined message that uses information entered during the attempt to establish the call connection. Nonami teaches using preformed messages, not messages that include information entered during the attempt to establish the call connection. Moran teaches pre-recorded messages, not messages that include information entered during the attempt to establish the call connection.

Finally, the Examiner cites *In re Keller* to support his position that the combined teachings of the references read on the claim. Although obviousness is tested by “what the combined teachings of the references would have suggested to those of ordinary skill in the art.” *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981), it “cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.” ACS Hosp. Sys., 732 F.2d at 1577, 221 USPQ at 933. Also, “teachings of references can be combined only if there is some suggestion or incentive to do so.” *Id.* Here, the prior art contains none. Instead, the Examiner relies on hindsight in reaching his obviousness determination. *In re Stencel* (CAFC) 4 USPQ2d 1071 (9/2/1987). And still further, to invalidate claimed subject matter for obviousness, the combined teachings of the prior art references must suggest, expressly or by implication, the improvements embodied by the invention. *In re Sernaker*, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983).

Nonami needs to establish a connection with the SMS service to send a short message. It can be presumed that for the short message to be received by the SMS, the connection would indeed need to actually be established, otherwise, the short message could not be received by the SMS. The Examiner agrees that at least an attempt to establish a call is performed by Nonami, as set forth in the Response to Arguments section of the Office Action on page 3, “the formed message is then transmitted from the antenna.” Nonami does not teach or disclose if a call connection is not established, i.e. fails, and of course Nonami would not teach or disclose operations that occur if a call connection is not established, i.e. fails, since Nonami deals with forming messages that are sent and received in a SMS.

Moran must also establish a call in order to send its prerecorded message. In Moran, the

call must be established with the messaging server in order to provide its services. Moran does not teach or disclose if a call connection is not established, i.e. fails.

Therefore, it is reiterated that in the combination of Nonami and Moran, there is never a situation where a call is not established, i.e. fails. Therefore, any operations subsequent to and based on the condition that “if the call connection between the mobile terminal and the counterpart mobile terminal fails”, namely using information entered during the attempt to establish the call connection to transmit a predetermined message associated with the one-touch call button, cannot be sustained.

Further, even if it were able to be sustained, which it is not, there are at least three distinct steps of Claim 4 and 8, along with their conditions precedent, that are not taught or disclosed by the combination of Nonami and Moran. Claims 4 and 8 recite, at least:

- (1) attempting to establish a call connection with a counterpart mobile terminal using the mobile terminal;
- (2) pressing a one-touch call button of the mobile terminal; and
- (3) transmitting a predetermined message corresponding to the one-touch call button (Claim 4) or a phone number and a predetermined message corresponding to the one-touch call button (Claim 8) to the counterpart mobile terminal.

The transmission process is conducted if the call connection between the mobile terminal and the counterpart mobile terminal is **not** established, i.e. fails. The transmission process uses information entered during the attempt to establish the call connection. These distinct steps and conditions in their recites order are not and cannot be disclosed by either Nonami or Moran, or any combination thereof.

In summary, the claims of the present application relates to, by using a one-touch menu or button when attempting to establish a call connection, transmitting a user’s phone number (or a short message) to a phone number of a counterpart mobile terminal. Such a feature of the present invention is patentably different from the feature in Moran that when the mobile terminal is

connected to a messaging server, a voice mail or an answering service are able to be used, thereby transmitting a message.

In addition, Nonami is directed to dialing "already registered phone numbers", and fails to teach or disclose storing the phone number of the counterpart mobile terminal in the memory during the attempt to establish the call connection and transmitting a message by using such information without inputting the phone number thereof again.

Based on at least the foregoing, withdrawal of the rejection of Claims 4 and 8 is respectfully requested.

Independent Claims 4 and 8 are believed to be in condition for allowance. Without conceding the patentability per se of dependent Claims 5-7, 9 and 10, these are likewise believed to be allowable by virtue of their dependence on their respective amended independent claims. Accordingly, reconsideration and withdrawal of the rejections of dependent Claims 5-7, 9 and 10 is respectfully requested.

Accordingly, all of the claims pending in the Application, namely, Claims 4-10, are believed to be in condition for allowance. Should the Examiner believe that a telephone conference or personal interview would facilitate resolution of any remaining matters, the Examiner may contact Applicant's attorney at the number given below.

Respectfully submitted,



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